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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: TRAYLOR, Marc

Serial No.: 09/751,609

Filed: December 28, 2000

For: RESILIENT MAGNETIC PAINT
BRUSH HOLDER

Art Unit: 3632

Examiner: Szumny, Jonathon A.

CERTIFICATE OF MAILING

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October 6, 2003

Date

Rhonda L. Mason

A handwritten signature in black ink that reads "Rhonda L. Mason".

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APPEAL BRIEF UNDER 37 C.F.R. § 1.192

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits this appeal brief under 37 CFR § 1.192 appealing the continued rejection of Claims 1-20 in Paper No. 10.

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(1) Real Party in Interest

The real party in interest in the subject application is Marc Traylor.

(2) Related Appeals and Interferences

No related appeals or interferences are known to appellant.

(3) Status of Claims

Claims 1-6 were submitted for examination in the application filed on December 28, 2000.

Claims 7-20 were added by amendment.

Claims 1-20 are pending.

Claims 1-20 are appealed.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagy, U.S. Patent 3,729,158 (*Nagy*).

(4) Status of Amendments

Amendment "A" filed on June 3, 2002 in response to the non-final rejection mailed on December 3, 2001 has been entered.

Amendment "B" filed on September 16, 2002 in response to the final rejection in Paper No. 6 has been entered.

Amendment "C" filed on January 15, 2003 in response to the non-final rejection in Paper No. 8 has been entered.

(5) Summary of Invention

The instant application discloses a magnetic paintbrush holder (6) for attaching to a paint can that advantageously reduces acceleration between the paintbrush and the paint can when the paint can is suddenly picked up or set down to prevent the paintbrush from sliding off the magnet. The paintbrush holder includes a resilient member (7) having a proximal portion attached to a clamp (5) and a distal portion attached to a magnet (1). The resilient member(7) has a force constant that is selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet.

(6) Issues

The following issues are presented for review:

Issue 1: whether the modification proposed by the rejection has a reasonable expectation of success;

Issue 2: whether the claimed force constant is inherent in *Nagy*;

Issue 3: whether the claimed invention as a whole is obvious over *Nagy*; and

Issue 4: whether the rejection establishes a motivation in the prior art to make the proposed modification.

(7) Grouping of Claims

A statement that the claims of a group do not stand or fall together is not included with this appeal brief.

(8) Argument

Issue 1: the modification proposed by the rejection lacks a reasonable expectation of success

The rejection errs on page 3 of Paper No. 10 in alleging that the vertical leg (24) in *Nagy* is equivalent to the claimed resilient member and in alleging that it would be obvious to an ordinary artisan at the time the invention was made to select the vertical leg (24) in *Nagy* to limit acceleration of the paintbrush. In the abstract, *Nagy* teaches away from the claimed resilient member by expressing a preference for implementing the vertical leg (24) as a metal strap to support the paintbrush. *Nagy* does not teach or suggest that the vertical leg (24) has a force constant selected to produce a displacement of the distal end to reduce acceleration of the paintbrush so that the paintbrush does not slide off the magnet when the paintbrush is subjected to a mechanical shock. Further, *Nagy* shows that the vertical orientation of the metal strap is nearly parallel to the direction in which the paint can would be picked up or set down. As a result, most of the force between the paintbrush and the paint can acts to apply compression or tension in the metal strap, which would not reasonably result in a displacement that could reduce acceleration of the paintbrush. Because there is no reasonable expectation of success in the modification to *Nagy* proposed by the rejection as required by

Appeal Brief page 5 of 14
09/751,609

DOCKET NO. 3066.001
FETF: 73522

MPEP § 2143.02 (2100-127,128), there is insufficient support to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

The rejection argues on page 3 that the metal strap (24) in *Nagy* could be selected to limit the acceleration of the paintbrush to any degree "as a design choice", however, the rejection fails to explain how such a modification to the vertical metal strap (24) might be performed with a reasonable expectation of success, while Applicant has provided evidence to show that the modification proposed by the rejection has no reasonable expectation of success. Absent a sufficient explanation of how the proposed modification to *Nagy* might be made with a reasonable expectation of success, there is insufficient support to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Issue 2: the claimed force constant is not inherent in *Nagy*

The rejection further errs in alleging on page 2 that the claimed force constant is inherent in *Nagy*. Specifically, the rejection argues that the metal strap (24) in *Nagy* "inherently has a force constant which produces some displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that a paintbrush attached to the magnet does not slide off the magnet". The rejection is apparently arguing that any displacement of the distal portion is sufficient to prevent the paintbrush from sliding off the magnet, which clearly is not true as explained by Applicant in the specification on page 7, lines 17-23 as follows:

"By way of contrast, if the spring were replaced by a

rigid bracket such as those used in the prior art, the force constant K could be 3 lb. per hundredth of an inch (equals 3600 lb./ft.). It is seen that, in this example, the use of a spring instead of a rigid bracket reduces the maximum acceleration of the brush by a factor of 10, from 7.5'g' to 0.75'g', and the maximum downward force of the paintbrush is reduced from 4.25 pounds to 0.875 pound. The reduction in acceleration clearly makes the difference between the paintbrush remaining on the magnet and its being jarred off the magnet and falling into the paint."

As explained above, the vertical strap metal bracket disclosed in Nagy does not have a force constant sufficient to produce a displacement of the distal end to prevent the paintbrush from slipping off the magnet. Because the rigid bracket disclosed in Nagy does not have a force constant sufficient to produce a displacement of the distal end to prevent the paintbrush from slipping off the magnet, the claimed force constant is not inherent in Nagy as alleged by the rejection. Further, MPEP § 2112 (2100-52) states:

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 15321, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) . . ."

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons

of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient'. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999) . . ."

Because the rejection does not make clear that the missing force constant sufficient to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet is necessarily present in the vertical metal strap (24) disclosed in *Nagy*, and because the rejection relies solely on the argument that the claimed force constant could be selected to modify *Nagy* to arrive at the claimed invention, the rejection clearly fails to establish the alleged inherency of the claimed force constant according to MPEP § 2112.

Further, MPEP § 2112 (2100-52) states:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter 1990) (emphasis in original) . . ."

The rejection fails to provide a basis in fact and the technical reasoning to reasonably support the determination that the claimed force constant necessarily flows from *Nagy*. Because the rejection fails to provide a basis in fact and the technical reasoning to reasonably

support the determination that the claimed force constant necessarily flows from Nagy, the rejection fails to meet the requirements of MPEP § 2112 to support a rejection based on inherency. Further, Applicant has provided the technical reasoning above to reasonably support the determination that the claimed force constant cannot be inherent in Nagy.

Because the rejection fails to meet the requirements of MPEP § 2112 to support a rejection based on inherency, there is insufficient support to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Issue 3: the claimed invention as a whole is not obvious over Nagy

The rejection further errs on page 4 in dismissing the selection of the claimed force constant as a "user preference or a design choice" without considering the claimed invention as a whole. MPEP § 2141.02 (2100-120) states the following:

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) . . ."

Nagy does not consider acceleration of the paintbrush as a factor in preventing the paintbrush from slipping off the magnet, therefore there is no teaching or

suggestion in *Nagy* that would motivate one of ordinary skill to modify *Nagy* to arrive at the claimed invention as a whole.

The rejection further errs in failing to consider the problem discovered in Applicant's disclosure.

Specifically, MPEP § 2141.02 (2100-121) states the following:

"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103. *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) . . ."

Applicant's disclosure reveals the source of the problem of a paintbrush slipping from a magnet due to acceleration of the paintbrush. See, for example, page 3, lines 19-20 of the specification, which state: "His [Applicant's] main insight was in recognizing the need to mechanically isolate the paintbrush and magnet from the paint can." *Nagy* does not recognize or address the need to mechanically isolate the paintbrush and magnet from the paint can. Because the rejection fails to consider the invention as a whole and fails to consider Applicant's discovery of the problem solved, there is insufficient support to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

The rejection further errs on page 2 in alleging that *Nagy*'s vertical leg (24) arrives at the claimed invention because it "inherently acts as a spring whenever a force is applied perpendicularly to it". As may readily be appreciated from FIGS. 1 and 2 in *Nagy*, the force applied to the vertical leg (24) when the paint can (6) is picked up and set down is

substantially parallel to the vertical leg (24), not perpendicular as alleged by the rejection. Because Nagy does not disclose an arrangement of the vertical leg (24) that is perpendicular to the direction of force as alleged by the rejection, there is insufficient support to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Further, Nagy's vertical leg (24) illustrated in FIGS. 1 and 2 is a rigid bracket typical of the prior art recognized by Applicant on page 7, lines 17-23 of the specification as quoted above. There is no teaching or suggestion in Nagy that a force constant in the vertical leg (24) is capable of reducing the maximum acceleration of the paintbrush so that the paintbrush does not slide off the magnet when subjected to a mechanical shock. Because Nagy does not teach or suggest a force constant in the vertical leg (24) that is capable of reducing the maximum acceleration of the brush so that the paintbrush does not slide off the magnet when subjected to a mechanical shock, there is insufficient support to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Also, the rejection admits on page 3 that "Nagy fails to specifically teach the resilient member to limit acceleration of an object attached thereto to no more than 0.75g." The rejection argues on page 3 that the metal strap (24) "could be selected to limit the acceleration of the paintbrush to any number of certain degrees, and any specific degree, as a design choice". Again, the rejection errs in relying on the mere possibility that the claimed force constant "could be" selected to modify Nagy and in failing to show that the claimed force constant necessarily flows from Nagy as required by MPEP § 2112 to support a rejection under 35 U.S.C. § 103.

Appeal Brief page 11 of 14
09/751,609

DOCKET NO. 3066.001
FETF: 73522

**Issue 4: the rejection fails to establish a motivation in
the prior art to make the proposed modification**

The rejection further errs on page 3 in alleging that *Nagy* "inherently suggests" the claimed force constant selected to produce a displacement of the distal portion when subjected to a shock so that the paintbrush attached to the magnet does not slide off the magnet. As explained above, the mere possibility that *Nagy* might be modified to select the claimed force constant is insufficient to establish that the claimed force constant is inherent in *Nagy* according to MPEP § 2112. Because the rejection fails to establish that the claimed force constant is inherent in *Nagy*, there is no inherent suggestion to modify *Nagy* to arrive at the claimed invention. Because there is no suggestion to modify *Nagy* to arrive at the claimed invention, the rejection fails to establish a motivation in the prior art to make the proposed modification. Because the rejection fails to establish a motivation in the prior art to make the proposed modification, there is insufficient support to sustain the rejection of Claims 1-20 under 35 U.S.C. § 103.

Respectfully submitted,


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(9) Appendix

1. A paintbrush holder comprising:
a clamp for engaging a rim of a paint can;
a magnet for engaging a ferrule of a paintbrush; and
a resilient member having a proximal portion attached to
the clamp and having a distal portion attached to the magnet
wherein the resilient member has a force constant selected to
produce a displacement of the distal portion when the
paintbrush is subjected to a mechanical shock so that the
paintbrush does not slide off the magnet.

2. The paintbrush holder of Claim 1 wherein the
resilient member is a spring.

3. The paintbrush holder of Claim 1 wherein the
resilient member is a length of resilient material.

4. A paintbrush holder comprising:
a resilient member having a proximal portion attached to
a clamp for engaging the rim of a paint can and a distal
portion attached to a magnet for engaging a ferrule of a
paintbrush wherein the resilient member has a force constant
selected to produce a displacement of the distal portion when
the paintbrush is subjected to a mechanical shock so that the
paintbrush does not slide off the magnet.

5. The paintbrush holder of Claim 4 wherein the
resilient member is a spring.

6. The paintbrush holder of Claim 4 wherein the
resilient member is a length of resilient material.

7. A paintbrush holder comprising:
a magnet for engaging the ferrule of a paintbrush;
a clamp for engaging a rim of a paint can; and
a resilient member having a proximal end attached to the
clamp and a distal end attached to the magnet wherein the
resilient member has a force constant selected to produce a
displacement of the distal end when the paintbrush is
subjected to a mechanical shock so that the paintbrush does
not slide off the magnet.

8. The paintbrush holder of Claim 7 wherein the
resilient member is a spring.

9. The paintbrush holder of Claim 7 wherein the
resilient member is a length of resilient material.

10. The paintbrush holder of Claim 7 wherein the
resilient member limits acceleration of the paintbrush to no
more than 0.75 g.

11. The paintbrush holder of Claim 7 further
comprising the paintbrush.

12. The paintbrush holder of Claim 7 further
comprising the paint can.

13. A paintbrush holder comprising:
a magnet for engaging the ferrule of a paintbrush;
a magnet holder for bonding to the magnet;
a clamp for engaging a rim of a paint can; and
a resilient member having a proximal end attached to the
clamp and a distal end attached to the magnet holder wherein

the resilient member has a force constant selected to produce a displacement of the distal end when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet.

14. The paintbrush holder of Claim 13 wherein the resilient member, the magnet holder, and at least a portion of the clamp constitute a single molded structure.

15. The paintbrush holder of Claim 13 wherein the resilient member is a spring.

16. The paintbrush holder of Claim 13 wherein the resilient member is a length of resilient material.

17. The paintbrush holder of Claim 13 wherein the force constant of the resilient member is selected to limit acceleration of the paintbrush to no more than 0.75 g.

18. The paintbrush holder of Claim 13 further comprising the paintbrush.

19. The paintbrush holder of Claim 13 further comprising the paint can.

20. The paintbrush holder of Claim 1 wherein the force constant of the resilient member is selected to limit acceleration of the paintbrush to no more than 0.75 g.